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IN THE

Supreme Court of the United States

OCTOBER TERM, 1949.

No. 2.

GRAVER TANK & MFG. CO., INC., THE LINCOLN ELECTRIC COMPANY, GRAVER TANK & MFG. CORPORATION,

Petitioners,

vs.

THE LINDE AIR PRODUCTS COMPANY,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

RESPONDENT'S ANSWER TO PETITION FOR REHEARING DATED JUNE 9, 1950.

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June 20, 1950.

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The only issue upon which rehearing is requested is that of infringement. That issue has now had four judicial determinations—two of them by this Court. All four decisions held petitioners guilty of infringement of the Jones *et al.* patent.

Each of the grounds relied on in the second Petition for Rehearing, dated June 9, 1950, was raised specifically in connection with the original Petition, dated March 11, 1949 (see Petition, March 11, 1949, p. 1; Petitioners' Reply in Support of Petition, May 5, 1949, pp. 3-4). Each was briefed and argued at length before this Court (see, *e. g.*,

Respondent's Brief on Rehearing, pp. 13-21, 60-71; Respondent's Reply Brief on Rehearing, pp. 2-11, 15-16). Both were rejected by this Court's decision, rendered May 29, 1950 (see, particularly, Slip Opinion, pp. 1-2, 6-7).

It is petitioners, rather than this Court, who labor under a "serious misapprehension" (*cf.* Petition of June 9, 1950, p. 1). There has been no lack of consideration or understanding of petitioners' arguments by this Court. Petitioners stand convicted of infringement solely because of the lack of merit in their contentions.

In Answer to Pages 1-6 of the Petition—"1. The Court has adjudged infringement by attributing to the trial court findings it did not make."

As their first ground for asking this Court to hear their arguments a third time, petitioners contend that there were no findings to support the determination that manganese silicate, as used in the accused welding composition, is an "equivalent" of the alkaline earth metal silicates specified in the valid claims (Petition, p. 1). They charge that:

> *"the finding this Court says it affirms, the trial court refused to make; and the evidence this Court points to as supporting the finding, the trial court said it would not consider."* (Petition, p. 2; emphasis in original.)

They go on to complain, in bold face type:

> "The result is that a judgment is returned against these petitioners upon evidence no one has evaluated" (p. 5).

There is no truth in this contention.

The findings on equivalence which this Court affirmed are summarized in its opinion, as follows:

> "The trial judge found on the evidence before him that the Linconweld flux and the composition of the patent in suit are substantially identical in operation and in result. He found also that Linconweld is in all respects equivalent to Unionmelt for welding purposes. And he concluded that 'for all practical purposes, manganese silicate can be efficiently and effectively substituted for calcium and magnesium silicates as the major constituent of the welding composition.'" (Slip Opinion, p. 6)

The first sentence of the above quotation is based squarely upon the Trial Court's Finding of Fact No. 20 (R. 926). The second is based upon the Trial Court's Finding of Fact No. 21 (R. 926). The last incorporates a direct quotation from the Trial Court's opinion (R. 919). Such a finding, as petitioners, themselves, emphasize, is a finding entitled to full honor under Rule 52(a) of the Federal Rules of Civil Procedure (see Petition, p. 2).

Other findings to the same effect by the Trial Court are collected in respondent's main Brief on Rehearing (pp. 17-20).

Moreover, in thus attacking the decision of this Court, petitioners fail to mention that they, themselves, faced the issue of "equivalents" as a question of fact at the conclusion of the trial. They submitted a proposed finding of fact upon the issue of equivalency, as follows:

> "(g) Manganese is not an alkaline earth metal, and manganese silicate therefore cannot be considered to be an alkaline earth silicate; nor is it an equivalent thereof" (R. 939; underlining supplied).

The Trial Court flatly rejected and refused petitioners' proposed finding that manganese is not an equivalent, al-

though the Court did make a finding that manganese is not classed as an alkaline earth metal in chemical literature (R. 919).

Petitioners' own rejected finding refutes their present contention that the sole issue before the Trial Court was "identity" and that "equivalency" was not in question (Petition, pp. 5-6).

Petitioners' contention on this point, it should be noted, repeats, almost word for word, the argument made in their original Petition dated March 11, 1949 (pp. 1-7), and it is based upon the same misreading of a reference to the patent specification in Judge Swygert's opinion.

As pointed out in our main Brief on Rehearing (pp. 61-63), and again in our R Brief on Rehearing (pp. 7-8), this reference by the Tr dge did not bear on the issue whether equivalence existed. Instead, such reference was made solely and exclusively on the issue of whether the established "equivalence" of manganese and the alkaline earth metals was "known" at the date of the invention. This is demonstrated by the language which petitioners, themselves, quote from the opinion, namely:

> "no determination need be made whether it is a known chemical fact *outside* the teachings of the patent that manganese is an equivalent of calcium or magnesium" (R. 920; underlining supplied).

On this limited issue it was clearly proper for the Trial Court to call attention to the fact that the specifications of the patent, itself, disclosed such equivalence.

In this connection, the Trial Court also called attention to the fact that petitioners introduced no evidence that they had looked elsewhere for their information (Finding No. 22, R. 926). This was strong confirmatory evidence that such equivalence had in fact been made "known" to petitioners by the specification.

As respects the Trial Court's findings, therefore, the answer to petitioners' first point is to be found in the following statement in their Petition:

> "Respect for the trial court's findings fairly requires that those findings be accepted as written" (Petition, p. 3).

In Answer to Pages 6-10 of the Petition—"2. Since, as this Court points out, the prior art disclosed the use of manganese silicate, it follows as a matter of law, under this very opinion, that the accused flux cannot infringe."

The only other ground urged by petitioners is a renewal of their familiar argument that the holding of infringement will cause the patent to embrace the prior art Miller patent, No. 1,754,566, which taught the use of manganese silicate in welding fluxes (Petition, pp. 6-9; *cf.* Petitioners' Opening Brief Upon Rehearing, pp. 33-37, 64-67, and the refutation of the argument in our Reply Brief, pp. 6-7, 9, 15-16).

In making this argument, counsel for petitioners again seek to give the impression that Lincoln derived his flux from the Miller patent. They still do not have the temerity to come right out with such a statement; but they say the Lincoln flux is almost entirely manganese silicate, and that Miller simply taught manganese silicate (Petition, pp. 6-7). They thus imply that their flux is nothing more than the flux taught by the Miller patent. In so doing they ignore the actual facts of record.

Neither petitioners' flux nor that of Miller is simply "manganese silicate" (Finding No. 21, R. 926; Defts' Ex. 145, R. 969). As respects their own flux, petitioners' conclusion is based upon their assertion that it contains 88.49% manganese silicate. Such reasoning would justify the

claim that a man and a bucket of water are the same simply because the human body is 80% water.

As respects the Miller flux, the Trial Court expressly found that the Miller patent does not teach petitioners' infringing flux, which was taught only by the Jones *et al.* patent in suit. Thus, the Trial Court stated in its opinion:

> "The defendants contend that if it be determined that the Lincolnweld composition containing a major proportion of manganese silicate infringes any of the composition claims in issue, such claims have been completely anticipated by Miller Patents Nos. 1,741,031, 1,748,785 and 1,754,566, particularly the latter, which teaches the use of a manganese silicate coating in electric welding. But that Miller patent did not teach all that the Jones, et al. patent does * * *" (R. 920-21.)

Miller does not anticipate Jones, and affords no comfort to Lincoln, the copyist of Jones. Employing the reasoning used in this Court's decision of May 29, 1950 (Slip Opinion, p. 5), the differences between the teachings of Miller and Jones are so fundamental that no question "emerges" as to the "equivalence" of any particular ingredient which they employed.

Rather than following the teachings of Miller, Lincoln slavishly copied the welding composition invented by Jones *et al.*

The accused Lincolnweld 660 flux contains a halide salt in the proportions taught by the Jones *et al.* patent (R. 280; Finding No. 21, R. 926) The Miller patent says nothing of the use of a halide salt (R. 969).

The Lincolnweld 660 flux is manufactured in accordance with the mandatory instructions of the Jones *et al.* patent that the composition be anhydrous and be prepared so as to avoid gas-forming reactions at the time of welding

(R. 921). The Miller patent teaches exactly the contrary (Opinion, R. 920-921).

The accused Lincolnweld 660 flux contains alumina within the critical limits prescribed by the Jones *et al.* patent (R. 280; Finding No. 21, R. 926). The Miller patent is entirely silent as to the use of alumina (R. 969).

The accused Lincolnweld 660 flux is prepared so as to achieve the required physical condition specified in the Jones *et al.* patent of a glass-like substance characterized by vitreous fracture rather than a crystalline condition (R. 291-292). The Miller patent is silent as to this (R. 969).

Petitioners had their golden chance to show the derivation of their flux in the Trial Court, where there was opportunity for cross-examination and for the Court to pass upon the credibility of their witnesses. Instead they chose not to offer any proof on this point. Their client was forced to admit on the stand that there was nothing in the history of welding that could approach the accomplishments of the Jones invention (R. 466); and their Chief Engineer Landis testified that not one of the many hundreds of different flux combinations in the prior art could be made to operate in the same way as the Lincolnweld flux (R. 770).

If Lincolnweld had in fact been derived from Miller it would have been easy for petitioners to offer proof. Instead they successfully resisted our efforts to obtain their records showing the derivation of their flux. Moreover, the welding demonstrations given by petitioners did not include a demonstration of the operation of such Miller flux (see Defts' Ex. 119, off. R. 632, rep. R. 903).

The fact is that Lincolnweld 660 was not and could not be derived from the Miller patent. The real origin of the Lincolnweld flux was the Jones *et al.* composition,

differing in many substantive respects from Miller. As the Trial Court found (Finding No. 22, R. 926):

> "A person skilled in the art can produce the accused Lincolnweld 660 flux by following the teaching of the patent in suit. No evidence was introduced to show that the accused flux was derived from the prior art or by independent experiment, or from any source other than the teachings of the patent in suit."

This finding is fully confirmed by the facts and is the definitive answer to the petitioners' contention. As this Court properly recognized, once this is established, the Miller patent serves only to confirm that the substitution of manganese by Lincoln was but a colorable attempt to avoid literal infringement.

Conclusion.

This case has been heard in court four times. Every court which has passed on it has agreed unanimously that Jones *et al.* made a great contribution to the welding art.

Four times, petitioners have urged the contentions they now advance. All four times those contentions have been rejected, and petitioners have been convicted of copying the Jones *et al.* patent.

The petition should be denied so that at long last petitioners can be held accountable for their wrongdoing.

Respectfully submitted,

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June 20, 1950